

### **REMARKS**

In the Office Action mailed January 24, 2008 from the United States Patent and Trademark Office, claims 1-13 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,804,787, and claims 1-13 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of copending U.S. Application No. 11/057,097. Claim 14 was rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement and rejected claims 3, 8, and 9 under 35 U.S.C. § 112, second paragraph for being indefinite. Claims 15-20 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0097451 to Bjorksten et al. (hereinafter "Bjorksten"), claims 1-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,028,049 to Shelton (hereinafter "Shelton") in view of U.S. Patent Application Publication No. 2004/0139025 to Coleman (hereinafter "Coleman") and claims 7-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shelton in view of U.S. Patent Application Publication No. 2002/0013519 to Adams et al. (hereinafter "Adams").

Applicant therefore respectfully provides the following:

Claims 1-3, 8, 9, 11, and 14 are currently amended.

#### **Double Patenting Rejections:**

In the Office Action, claims 1-13 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,804,787, and were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of copending U.S. Patent Application

No. 11/057,097. The Office Action also indicated that the prior office action provided an analysis of the claims to support the rejection and that as the language of the patent is more specific than the claims of the instant application the claims are not patentably distinct.

Regarding the rejection over Patent No. 6,804,787, Applicant first notes that the double patenting rejections in both the prior and current office actions have been made without any recitation of claim language except 1) an indication that the instant application “generally claims a method for controlling a release of personal information,” and 2) a list of individual words from claim 1: “personal information,” “organizations,” “individual,” “enterprise/server,” and “to not release information . . . without receiving authorization from said individual.” (See Office Action at paragraphs 11-12.) Applicant respectfully notes that the mere listing of extracted words from claim 1 of the instant application fails to convey or in any way examine the actual meaning of the method claim. By way of illustration, claim 1 is provided below with the recited claim language underlined:

1. A method for controlling a release of personal information comprising:  
depositing some personal information regarding an individual with a server;  
obligating organizations that possess additional personal information regarding  
said individual to not disclose that additional personal information without  
authorization from said server; and  
instructing said server to not release said some personal information held on the  
server and to not authorize release of said additional personal information  
at the obligated organizations without receiving authorization from said  
individual.

It is worth noting that in this method claim, not one of the gerunds beginning the various limitations of the claim (depositing, obligating, or instructing) has been recited in the Office Action. Therefore, regardless of whether there are correlating words in the claims of Patent No. 6,804,787 to the underlined words of claim 1 listed above and in the Office Action, Applicant respectfully submits that the rejection set forth in the Office Action grossly fails to demonstrate

that claim 1 of the instant application is not patentably distinct from the claims of the patent. The rejection of the claims provided in the Office Action does not include an analysis of the claims to support the rejection, but only provides an analysis of a few selected similar words from the claim without any analysis as to claim meaning. No analysis of dependent claims 2-6 was provided in the Office Action. Therefore, a similar deficiency is present as to the rejections of those claims.

Furthermore, regarding claim 7 (and dependent claims 8-13), Applicant respectfully notes that the analysis provided in the Office Action is even farther from what is recited in the claim, and that the Office Action completely fails to analyze the limitations of claim 7. By way of illustration, claim 7 is provided below with the terms discussed in the Office Action underlined in the claim language:

7. A method for creating a database of verified personal information comprising:  
gathering information regarding an individual;  
presenting said information over a wide area computer network to said individual  
to review and verify said information's accuracy;  
accepting commentary on the accuracy of said information based on said review  
from said individual over the wide area computer network;  
including said commentary in said database with said information;  
receiving a request over said wide area computer network from an authorized  
individual to review selected portions of said information;  
presenting said request to said individual for authorization;  
presenting said selected portions of said information over said wide area computer  
network to said authorized individual; and  
providing access to said database and said commentary to third parties.

As may be seen from the claim, the claim completely fails to correlate with the rejection set forth in the Office Action. Additionally, Applicant again notes that not a single gerund of this method claim (gathering, presenting, accepting, including, receiving, presenting, or providing) has been

discussed in the Office Action. Therefore, the rejections of claims 7-13 cannot stand and should be removed.

Regarding the provisional double patenting rejections over claims 1-24 of copending U.S. Patent Application No. 11/057,097, Applicant also notes that similar problems are present for the rejection. Specifically, the only supposed claim language discussed in the rejections is a single phrase: "if the requested information is not subject to the requirement, releasing the requested information to the requestor." (See Office Action at paragraph 19.) Applicant respectfully notes that the recited language is simply not a part of any of the claims and never has been. Both quoted passages are from the copending application, and no analysis whatsoever of the instant application is set forth. Therefore, the rejections cannot stand and must be removed.

Applicant believes the comments submitted in the Response dated October 24, 2007 regarding the double patenting rejections are entirely relevant and clearly show that the claims of the instant application are patentably distinct. Rather than completely restate those arguments, Applicant refers the Examiner to those comments, which are explicitly incorporated by reference. Those arguments are provided on pages 10-16 of the October 24, 2007 Response. Applicant notes that the *Graham* inquiries necessary for a proper double patenting rejection require specific factual findings by the Patent Office regarding the scope and content of the prior art claims and the differences between the prior art claims and the claims of the instant application. (See M.P.E.P. §§ 2141 & 2142. See also, for example, the enumerated required articulations set forth in M.P.E.P. § 2143 for each lettered rationale.)

Applicant therefore respectfully requests removal of all double patenting and provisional double patenting rejections.

Rejection under 35 U.S.C. § 112, First Paragraph:

In the Office Action, claim 14 was rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Office Action indicated that the recited limitations of receiving a disclosure and receiving a contractual agreement were not described. M.P.E.P. § 2163 summarizes the applicable standard from court decisions concerning the written description requirement. It indicates that there is no *in haec verba* requirement (i.e. there is no requirement that the claim limitation be word-for-word what is contained in the specification), and that it is sufficient for claim limitations to be supported through “express, implicit, or inherent disclosure.” Thus, as set forth in M.P.E.P. § 2163, the requirement is satisfied if the patent specification describes the claimed invention “in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention.” Applicant respectfully submits that the rejected claim language satisfies this requirement.

Applicant points to the paragraph of the specification spanning pages 19-20 of the specification as filed, which states:

Figure 2 shows a flow chart of another embodiment of the present invention. In this embodiment, a user 100 enters into a relationship with an enterprise/server 102 using the software described herein. User 100 gives enterprise/server 102 confidential information and also discloses to enterprise/server 102 which financial organizations 104, medical organizations 106, pharmaceutical companies 108 and other organizations 110, hold confidential information about user 100. Enterprise/server 102 then contacts each of the organizations specified by user 100 and each organization contractually agrees to first contact enterprise/server 102 before releasing any information about user 100 to any third party 112. If third party 112, such as an insurance company, contacts one of the organizations that has personal information about user 100, that organization must first contact enterprise/server 102 before releasing such information. Enterprise/server 102 then contacts user 100 and if user 100 gives enterprise/server 102 authorization, enterprise/server 102 then instructs the organization to release the information to the third party 112.

(Emphasis added.) As may be seen from the rejected claim language, below, the written description in the specification clearly shows that the inventor had possession of the claimed invention. The rejected claim language is:

receiving a disclosure from said individual at said server identifying said organizations that possess said additional personal information;  
contacting said organizations that possess said additional personal information with said server; and  
receiving a contractual agreement from said organizations that possess said additional personal information to not release said additional personal information to third parties without first contacting said server for authorization

Therefore, Applicant respectfully submits that all limitations of claim 14 were described in the specification in such a way as to show that the inventor has possession of the claimed invention. In light of the description provided in the specification as filed, Applicant respectfully requests removal of the rejection.

Rejections under 35 U.S.C. § 112, Second Paragraph:

In the Office Action, claims 3, 8, and 9 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicant has corrected the issues raised in the Office Action and respectfully requests removal of the rejections.

Rejections under 35 U.S.C. § 102(e):

In the Office Action, claims 15-20 were rejected under 35 U.S.C. § 102(e) as being anticipated by Bjorksten. M.P.E.P. § 2131 sets forth the standard for a rejection of a claim as anticipated under 35 U.S.C. § 102. "To anticipate a claim, the reference must teach every element of the claim." M.P.E.P. § 2131 states further,

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."  
*Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d

1051, 1053 (Fed. Cir. 1987). . . . “The identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicant respectfully submits that Bjorksten fails to teach every element of the claim set as provided herein for at least the following reasons.

Independent claim 15 is a method claim that requires: “automatically gathering information regarding an individual from a plurality of information sources over a wide area computer network.” Bjorksten fails to teach automatically gathering information regarding an individual from a plurality of information sources. Instead, Bjorksten teaches the use of an automatic information collector for capturing personal information about a user. (Para 0046) Bjorksten teaches how the automatic information collector gathers information about the user at Figure 15 and paragraphs 0116-0118. This teaches that the automatic information collector monitors the user’s interactions with websites and collects the information based on the user’s requests and the user’s responses to requests for information. (Para 0117) Therefore, the automatic information collector of Bjorksten does not gather information from a plurality of information sources, but only gathers information from the user as the user interacts with websites. Therefore, Bjorksten does not teach this limitation of claim 15.

Claim 15 also requires “presenting said information and the sources of said information over the wide area computer network to said individual to review and verify said information’s accuracy.” Bjorksten fails to teach presenting the sources of information to the individual for review, as in Bjorksten all information comes from the user (see above). The Office Action cites paragraphs 0040-0041 regarding presenting information to the user. This portion does not teach presenting sources of information to the individual, but merely teaches user creation, editing, and

controlling the sharing of a master profile of the user's information. Therefore, Bjorksten does not teach this limitation of claim 15.

Claim 15 further requires: "accepting commentary on the accuracy of said information based on said review from said individual over the wide area computer network" and "including said commentary in said database with said information." These limitations are not taught by Bjorksten. Bjorksten teaches that the user may edit the profile, but does not teach the acceptance of any commentary on the accuracy of information or the inclusion of such commentary with the information. Therefore, Bjorksten does not teach these limitations of claim 15 as set forth in the claim.

Claim 15 also recites: "presenting said selected portions of said information over said wide area computer network to said authorized individual along with identification of said sources of said selected portions of said information and any commentary on the accuracy of said selected portions of said information provided by said individual" and "providing access to said database and said commentary to third parties." Such limitations are not taught by Bjorksten, as Bjorksten fails to teach storing of any commentary or identification of sources of information (see above) and therefore also fails to teach presenting these or providing access to these features to others.

Therefore, for at least the foregoing reasons, Applicant respectfully submits that Bjorksten fails to teach all elements of claim 15. Claims 16-20 depend on claim 15, and are therefore allowable for at least the same reasons. Applicant therefore respectfully requests removal of all rejections under 35 U.S.C. § 102(e).



Rejections under 35 U.S.C. § 103(a):

In the Office Action, claims 1-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shelton in view of Coleman and claims 7-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shelton in view of Adams. M.P.E.P. § 2141 sets forth the *Graham* factual enquiries that should be considered when making an obviousness rejection under Section 103: 1) ascertaining the scope and content of the prior art; 2) ascertaining the differences between the claimed invention and the prior art; and 3) resolving the level of ordinary skill in the pertinent art. (Citing *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).) In addition, M.P.E.P. §§ 2141 and 2142 set forth that “the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.” (Citing *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. \_\_\_, 82 USPQ2d 1385 (2007).)

Therefore, for a rejection under Section 103 to stand, it must explicitly set forth 1) factual findings showing that each claim element was known in the art at the time of the invention, and 2) factual findings showing that one of ordinary skill in the art, at the time of the invention, would have found it obvious to modify or combine the teachings to arrive at the claimed invention. (See, for example, the enumerated required articulations set forth in M.P.E.P. § 2143 for each lettered rationale.) Applicant respectfully submits that the references cited by the Examiner, either alone or in combination, do not teach or suggest all the limitations claimed in the claim set provided herein. Therefore, Applicant respectfully submits that the differences between the cited references and the claimed invention show that the claimed invention is not made obvious by the cited references.

Regarding claims 1-6:

Claims 1-6 were rejected over Shelton and Coleman. Independent claim 1, as amended, requires: “A method for controlling a release of personal information comprising: depositing some personal information regarding an individual with a server; obligating organizations that possess additional personal information regarding said individual to not disclose that additional personal information without authorization from said server; and instructing said server to not release said some personal information held on the server and to not authorize release of said additional personal information at the obligated organizations without receiving authorization from said individual.” Applicant respectfully submits that such limitations are not taught by the cited references, either alone or in combination.

Applicant refers to Applicant’s prior arguments on this matter and provides the following additional comments. In the Office Action, reference was made to organizations that possess additional personal information regarding said individual to not disclose that additional personal information without authorization from said enterprise/server. (Page 10, second paragraph) The entities cited in the office action at Col 9 lines 9-18, Col 9 lines 57-63, Fig 1 elements 10-c, Col 7 lines 40-50, Col 10 lines 18-36, Col 9 lines 1-8 and Col 10 lines 53-Col 11 line 45 are all entities requesting patient information, not entities possessing additional personal information as is required by the claim. Therefore, these entities do not read on the recited organizations of claim 1, and no obligations are made on such parties in the system of Shelton.

Coleman also fails to teach such limitations. Coleman teaches a system that provides privacy notices regarding an individual’s personal information to various third parties.

(Abstract) However, the interaction with third parties is entirely limited to two basic interactions. First, sending notices to the third parties requesting that no disclosure occurs. (Para

[0059]) Second, personal information may be sold or given to third parties with permission from the individual (Para [0044]), but such transactions are disclosed as occurring entirely from a centralized information trust (Para [0079], see also “Data Flow” on Figures 7-9 from “Information Trust” labeled 300). Therefore, Coleman fails to teach the recited claim limitation regarding obligating, as Coleman merely teaches a notice instructing other organizations to not disclose any information in any form, and does not obligate organizations possessing additional personal information to not disclose the information without authorization from a server. Coleman also fails to teach the claim limitation regarding instructing said server, as Coleman only teaches a release of information from a single repository, and therefore does not teach instructing the server to not authorize release of the additional personal information at the obligated organizations without receiving authorization from the individual.

Therefore, for at least these reasons, Applicant respectfully submits that the cited references, either alone or in combination, fail to disclose every element of claim 1. Claim 1 is not obvious in light of the cited references at least because of the limited scope of the cited art and because of the differences between the claim and the cited art. Claims 2-6 depend from claim 1 and are therefore allowable for at least the same reasons.

Regarding claims 7-13:

Claims 7-13 were rejected over Shelton and Adams. Independent claim 7 requires:

A method for creating a database of verified personal information comprising: gathering information regarding an individual; presenting said information over a wide area computer network to said individual to review and verify said information's accuracy; accepting commentary on the accuracy of said information based on said review from said individual over the wide area computer network; including said commentary in said database with said information; receiving a request over said wide area computer network from an authorized individual to review selected portions of said information; presenting

said request to said individual for authorization; presenting said selected portions of said information over said wide area computer network to said authorized individual; and providing access to said database and said commentary to third parties.

The limitations of claim 7 are not taught by the cited references, either alone or in combination.

The Office Action indicated that Shelton does not teach the claim limitations of “presenting said information over a wide area computer network to said individual to review and verify said information’s accuracy,” “accepting commentary on the accuracy of said information based on said review from said individual over the wide area computer network,” and “including said commentary in said database with said information.” Applicant agrees; however, Applicant respectfully disagrees with the assertion in the Office Action that Adams teaches such limitations.

Adams teaches a patient test result delivery system. (Abstract) In the system of Adams, the patient may access the system, and may update the patient’s profile. (Para [0109]) Presumably, as the patient updates the profile, the patient reviews and verifies the information’s accuracy. However, nothing in Adams teaches receiving or accepting commentary on the accuracy of information, including said commentary in the database, and “providing access to said database and said commentary to third parties,” as is required by claim 7.

The Office Action relies on Adams’ teaching of a checking of a release box as teaching accepting commentary. Applicant respectfully disagrees. The checking of a release box is clearly disclosed in Adams as permitting a certain physician to see certain test results that the physician otherwise would not be able to see. (Para [0118]) Nothing in Adams teaches or suggests that releasing the information to the physician should be equated with providing commentary on the accuracy of any information, including the commentary on the accuracy of

the information on the database and providing access to the commentary to third parties, as is required by claim 7.

Therefore, Applicant maintains that Adams fails to teach the limitations of claim 7 that are not taught by Shelton. Therefore, claim 7 is not made obvious by the cited references given the differences between the claims and the cited references. Claims 8-13 depend from claim 7 and are at least allowable for the same reasons.

In addition, claim 11 has been amended to recite that the commentary includes explanations of incorrect information in said database. The amendment is supported by the specification as filed at least at page 25 lines 10-12. Such additional limitations are not taught by the combination of Shelton and Adams, and claim 11 is therefore additionally allowable for this reason.

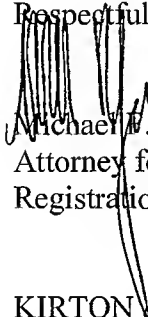
Applicant therefore respectfully requests the removal of the rejections of claims 7-13 under 35 U.S.C. § 103(a) for at least the above reasons.

**CONCLUSION**

Applicant submits that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicant requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 24 day of April, 2008.

Respectfully submitted,

  
Michael A. Krieger  
Attorney for Applicant  
Registration No.: 35,232

KIRTON & McCONKIE  
1800 Eagle Gate Tower  
60 East South Temple  
Salt Lake City, Utah 84111  
Telephone: (801) 321-4814  
Facsimile: (801) 321-4893